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In re Application of
Schlessinger, et al.

Application Serial No.: 10/049,429

PCT No.: PCT/US00/23744

Intl. Filing Date: August 30, 2000

Priority Date: 30 August 1999

Attorney's Docket No.: 038602-1306

For: CRYSTAL STRUCTURES OF DOMAINS OF
RÉCEPTOR PROTEIN TYROSINE KINASES
AN THEIR LIGANDS

DECISION ON REQUEST
UNDER 37 CFR 1.497(d)

This is a decision in response to the "Petition under 37 CFR 1.48(a) to Correct Inventorship" filed 14 February 2003, which is being treated as a request under 37 CFR 1.497(b) to correct inventorship.

BACKGROUND

On 30 August 2000, applicant filed international application PCT/US00/23744 that claimed priority of an earlier provisional application filed in the United States on 30 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 30 March 2001 prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee for the national stage expired at midnight on 30 March 2002.

On 12 February, 2002, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by a copy of the international search report and the basic national fee of \$890.00 as required by 35 U.S.C. 371(c). These papers were assigned application number 10/049,429.

On 16 April 2002, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" indicating that applicant was required to file an oath or declaration and a surcharge fee. The notification set an extendable period for reply of two months from its mailing date in which to respond. A response was filed on 16 October 2002, along with an extension of time within the fourth month pursuant to 37 CFR 1.136(a). The response of 16 October 2002 was deficient and the United States Patent and Trademark Office mailed the "Notification of Defective Response" on 16 January 2003 and indicated that the oath or declaration was not proper as it was executed by inventors not listed in the international application. The "Notification of Defective Response" allowed a one month period for response. Extension of time were available pursuant to 37 CFR 1.136(a).

In order to satisfy the requirements of 35 U.S.C. 371(c)(4), on 12 May 2003, applicants filed the following papers:

- 1) declarations signed by inventors Alexander Plotnikov, Zhongtao Zang, and Xiang-Peng Kong;

2) "Statement Supporting Correction of Inventorship Under 37 CFR 1.48(a)" authored by the above-cited inventors, and

3) "Consent of Assignee for Correction of Inventorship."

DISCUSSION

A request under 37 CFR 1.497(d) to correct inventorship must be accompanied by (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part, (2) the processing fee set forth in 37 CFR 1.17(I), and (3) the written consent of the assignee, if an assignment has been executed by any of the original named inventors.

With respect to item (1), applicant has not provided the required statement from inventors Plotnikov, Zhang, or Kong. The statements provided do not stipulate that the error in inventorship in the international application occurred without deceptive intent, rather only stipulate that the error "... that caused the inventive entity to be set forth in error in the executed Declaration submitted pursuant to 37 CFR 1.63 in the ... [national stage] application arose without deceptive intent ..."

Relative to item (3), the "Consent of Assignee for Correction of Inventorship" is lacking in that it does not properly establish, pursuant to 37 CFR 3.73(b), the assignee's right to act in the application as is required by 37 CFR 1.497(d)(3). Applicant must provide documentary evidence that complies with the requirements of 37 CFR 3.73 establishing the assignee's right to act in the above-cited application. Further, the "Consent of Assignee for Correction of Inventorship" does not establish that the person who signed the consent is authorized to act on behalf of the assignee. Section 3.73(b)(2) of Title 37 of the Code of Federal Regulations requires the person signing the document establishing ownership on the part of the assignee include a statement that the person is authorized to act on behalf of the assignee or that the person has "apparent" authority to act on behalf of the assignee. The authority of the person who signed the "Consent of Assignee for Correction of Inventorship" is not "apparent", therefore; applicant must provide a statement that said person is authorized to act on behalf of the assignee.

It is further noted that the declaration filed with the instant petition is defective in that it is a compilation of several declarations rather than one complete declaration signed by all named inventors, or complete declarations for each named inventor with all signature pages attached. The defect in the declaration is evidenced by the presence of two pages labeled "3 of 4" and several other pages labeled "4 of 4". Applicant must file a proper declaration with any renewed petition filed.

CONCLUSION

The request under 37 CFR 1.497(d) is **DISMISSED without prejudice.**

If reconsideration on the merits of this request is desired, a proper response must be filed within

TWO (2) MONTHS from the mail date of this decision. A proper response would include the submission of the requirements under 37 CFR 1.497(d) indicated as unfulfilled above. Any reconsideration should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)." No additional fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file the proper response will result in **ABANDONMENT** of the application.

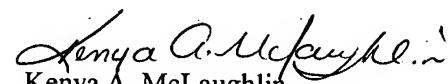
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